

Remarks

Claims 1-5 and 7-19 are pending and stand rejected. No Claims have been amended. Applicants assert that the claims are in condition for allowance as set forth more fully below.

103 Rejections

Claims 1-5 and 7-19 stand rejected under 35 USC 103(a) as being unpatentable over Madsen (US Pat. 6,174,205) in view of “Corning, Toolless Wall-mount Distributed Microfilter, July 2001” (“Corning”). Applicants respectfully traverse these rejections.

The Office Action has rejected base claims 1, 7 and 11 by stating that Madsen teaches all of the elements except the steps of receiving a combined POTS/DSL signal and then separating these signals by filtering. However, the Office Action states Corning teaches the filtering of a combined POTS/DSL signal such that it would have been obvious to combine Corning (wherein the filter is most likely inside the [PCMCIA] cartridge **52** (See, Office Action Page 5)), with the disclosure of Madsen to render claims 1, 7 and 11 obvious.

However, claims 1, 7 and 11 each recite similar subject matter that would render the Office Action’s asserted combination to be non-functional. Therefore, the asserted combination would render the prior art being modified unsatisfactory for its intended purpose and, as such, there is no suggestion or motivation to make the asserted combination. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984); MPEP 2143.01. Furthermore, the prior art can be modified or combined to reject claims as obvious only as long as there is a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091 (Fed. Cir. 1986); MPEP 2143.02.

Claim 1

As a representative example, claim 1 recites among other things:

“a telephone ... the first end including at least one electrical connector for engaging the corresponding electrical connector for the POTS circuitry... the filter cartridge comprises circuitry to receive a signal through the at least one second connector of the second end that contains both DSL and POTS signals, to filter the DSL signal out so as to pass substantially only the POTS signal to the at least one electrical connector of the first end, and to simultaneously pass the DSL signal to the at least one first connector of the second end for receiving the DSL line.”

In short, claim 1 requires that the POTS signal be outputted from the first end to the at least one electrical connector connected to the POTS circuitry, all of which occurs inside the housing. Furthermore, it is commonly known in the art that POTS signal operates at approximately -48 volts DC.

The Office Action asserts that the Madsen device is directly connected to a phone line 114/116 and a PCMCIA card 52, that the Corning POTS/DSL filter would be inside the PCMCIA card 52 and that the PCMCIA card would terminate inside the telephone housing 14. As commonly known in the art, a PCMCIA card terminates into a PCMCIA bus that operates at approximately 3V. The asserted operation of the combination of Madsen and Corning, according to the Office Action, would therefore require the -48V POTS signal to connect to a PCMCIA bus (an electrical connector connected to a POTS circuit) in order for the PCMCIA card to seat and function. However, connecting a -48v POTS output signal into a 3V PCMCIA bus would overload the PCMCIA bus and render it inoperative. In addition, it is well known in the art that in addition to the voltages being different, the signaling methodology of POTS is also different and incompatible with the signaling methodology of a PCMCIA buss.

In the alternative, to prevent an overload condition in the PCMCIA bus, the POTS/DSL filter would have to be outputted to intervening circuitry also inside the PCMCIA card such that the POTS signal would no longer be outputted from the first end and would therefore fail to disclose all the elements recited in claim 1. Because the combination of Masden and Corning would be non-functional, there would be no suggestion or teaching such that one skilled in the art would have been able to combine those references with any reasonable expectation of success. MPEP 2143.02.

Claims 7 and 11

Claims 7 and 11 recite subject matter similar to that in claim 1. In specific, Claim 7 recites:

“A filter cartridge adapted for use with a telephone comprising a first end and second end, the first end being adapted to be inserted into a location within a housing of the telephone; the first end including at least one electrical connector for engaging a corresponding electrical connector within the telephone that is for carrying POTS signals to POTS circuitry of the telephone and... wherein the cartridge includes circuitry to filter the DSL signal out of the signal received...so as to output substantially only the POTS

signal through the at least one electrical connector of the first end and output the DSL signal through the at least one DSL connector of the second end.”

Claim 11 recites:

“A filter cartridge adapted for use with a telephone comprising a first end and second end, the first end being adapted to be inserted into a location within a housing of the telephone, the first end including at least one electrical connector for engaging a corresponding electrical connector within the telephone that is for carrying POTS signals to POTS circuitry of the telephone... a filter that removes the DSL signal so as to output substantially only a POTS signal through the at least one electrical connector of the first end...”.

As discussed in relation to claim 1, the combination of Masden and Corning as asserted by the Office Action regarding claims 7 and 11 again necessarily requires that a POTS signal be transferred from the PCMCIA card to a connector within the housing (a PCMCIA bus) in order for the PCMCIA card to seat and function. In that case the -48V POTS signal would again be incompatible with the 3V PCMCIA bus and malfunction. As such, the combination of Masden and Corning would again be non-functional. Therefore, the asserted combination would render the prior art being modified unsatisfactory for its intended purpose and there is no suggestion or motivation to make the asserted combination. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984); MPEP 2143.01.

Accordingly for at least the reasons given above, claims 1, 7 and 11 are allowable over the cited combination of Madsen and Corning for at least these reasons. Dependent claims 2-5, 8-10 and 12-19 depend from allowable claims 1, 7 and 11 and are also allowable for at least the same reasons.

Conclusion

Applicants assert that the application including claims 1-5 and 7-19 is in condition for allowance. Applicants request reconsideration after final in view of the remarks above and further request that a Notice of Allowability be provided. Should the Examiner have any questions, please contact the undersigned.

No fees are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

Date: September 1, 2005

A handwritten signature in black ink, appearing to read "Jeramie J. Keys", written over a horizontal line.

Jeramie J. Keys

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